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Paper No.

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AUG 14 2008

OFFICE OF PETITIONS

In re Application of	:	
Alexander S. Kozlov, Derek	:	
Raybould, Siu-Ching D. Lui, and	:	
Thomas E. Strangman	:	
Application No. 10/753,675	:	DECISION ON PETITION
Filed: January 7, 2004	:	PURSUANT TO
Attorney Docket No. H0005756-	:	37 C.F.R. § 1.47(A)
1060	:	
Title: PLATINUM ALUMINIDE	:	
COATING AND METHOD THEREOF	:	

This is in response to the petition pursuant to 37 C.F.R. § 1.47(a), filed June 18, 2008.

This petition pursuant to Rule 1.47(a) is **DISMISSED**.

On January 7, 2004, the application was filed, identifying Alexander S. Kozlov, Derek Raybould, Siu-Ching D. Lui, and Thomas E. Strangman as joint inventors. The application was deposited without a fully-executed declaration: the word "deceased" was written on the signature block that is associated with Mr. Kozlov. It appears that this was not picked up by the Office on initial deposit, and the need for a fully executed declaration was first set forth in the Notice of Allowance and Issue Fee Due that was mailed on March 18, 2008.

A grantable petition pursuant to 37 C.F.R. § 1.47(a) requires:

- (1) the petition fee of \$200;
- (2) a surcharge of either \$65 or \$130 if the

- petition is not filed at the time of filing the application, as set forth in 37 C.F.R. § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
 - (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort, and;
 - (5) a declaration which complies with 37 C.F.R. § 1.63.

With this petition, Petitioner has asserted that the non-signing inventor is deceased and that the legal representative of the non-signing joint inventor is unavailable. **This petition is being construed to contain a statement setting forth that the legal representative has refused to execute the declaration.** Petitioner has further submitted, *inter alia*, copies of letters, two declarations of fact, and the last-known address of the legal representative of the non-signing joint inventor.

Petitioner has met requirements (1) - (3) of 37 C.F.R. § 1.47(a).

Regarding the second requirement of Rule 1.47(a), the surcharge that is required due to the fact that this petition was not submitted on filing has been charged to Petitioner's Deposit Account.

Regarding the fourth requirement of Rule 1.47(a), it does not appear that a complete copy of the application was sent to the last-known address of the legal representative. It is clear that two packages were sent to the legal representative, and it appears that a complete copy of the application was not included in the same¹. Where a refusal of a legal representative to sign the application papers is alleged, the Office requires the petitioner to establish that a bona fide attempt was made to mail a complete copy of the application, which entails the

¹ See Kwacala declaration of facts, paragraph 5 and Cantore declaration of facts, paragraph 2.

specification, claims, drawings, and oath or declaration². As no mention has been made of any presentation of a complete copy of the application to the legal representative, the fourth requirement has not been met.

It follows that since it has not been shown that a complete copy of the application was sent to the legal representative, one cannot refuse to sign something which one has not seen. A refusal by a legal representative to sign an oath or declaration when the individual has not been presented with the application papers does not itself suggest that he/she is refusing to join the application unless it is clear that he/she understands exactly what he/she is being asked to sign and refuses to accept the application papers.

It is reasonable to require that the legal representative be presented with the application papers before a petition under Rule 1.47 is granted since such a procedure ensures that she is apprised of the application to which the declaration is directed³.

Before filing the renewed petition, **Petitioner should mail a complete copy of the application to the legal representative, and provide her with a reasonable period of time to respond.** Petitioner should note that any statement that pertains to the presentation should be made by one having firsthand knowledge of the event. Statements based on hearsay are not normally accepted.

Regarding the fifth requirement of Rule 1.47(a), the declaration that was submitted on initial deposit cannot be accepted, as it fails to comply with 37 C.F.R. § 1.64(b) - the declaration fails to:

- contain the name of the legal representative;
- state that she is a legal representative, and;
- list her citizenship, residence, and mailing address.

Petitioner will note that any declaration that is prepared in response to this decision should clearly indicate that the non-signing inventor is deceased.

Any renewed petition must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R.

² See MPEP § 409.03(d).

³ In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

§ 1.47(a).” This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web⁷.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.

The general phone number for the Office of Petitions that should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225⁸. All other inquiries concerning

4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

6 (571) 273-8300- please note this is a central facsimile number.

7 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

8 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any of Petitioner's further action(s).

examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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